



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/476,319 12/30/99 HASEBE

T P21-9028

TM02/0119
NIKAIDO MARMELESTEIN MURRAY & ORAM LLP
655 FIFTEENTH STREET NW
SUITE 330
WASHINGTON DC 20005-5701

EXAMINER

BARRON JR, G

ART UNIT

PAPER NUMBER

2132

DATE MAILED:

01/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/476,319

Applicant(s)

HASEBE ET AL.

Examiner

Gilberto Barrón Jr.

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☒ received in Application No. (Series Code / Serial Number) 08/031,339.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Reissue Applications

1. The Response to the First Office Action has been carefully considered, but is not persuasive in overcoming the rejection of claims based on the Matyas reference. The grounds of rejection have been clarified to address Applicant's arguments. Additionally, new issues of improper recapture of surrendered subject matter and non-statutory subject matter are raised herein.

Claim Rejections - 35 USC § 102

2. Claims 1-2, 6-7, 11-12 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Matyas (4,757,534 hereinafter as '534).

The '534 patent discloses a software protection system for a storage medium (a diskette) accessed by a storage readable apparatus (a user computer). The protection system provides for a medium personal number unique to each storage medium written onto the storage medium in an un-rewritable form which a user storage readable apparatus cannot rewrite. See Figure 2 and 7 of '534 where the diskette serial number, see col. 5, lines 30-37 is indicated as recorded in the header record of the diskette, which is an un-rewritable form. The diskette serial number is used in the generation of the decryption key for decrypting the encrypted electronic data (as in claims 1-2) or generating an encrypted permission information (as in claims 6-7 and 11-12) or for decrypting the encrypted electronic information which is encrypted based on the medium personal number (as in claims 17 and 18).

3. Applicant's argument that the instant invention does not generate a password from the diskette serial number, user computer number and program number as

Art Unit: 2132

disclosed in Matyas is not persuasive. The examiner is not suggesting that the password is comparable to the recited medium personal number. Rather, that Matyas discloses using a diskette serial number, among other information, to generate the encryption/decryption key. The claims, given their broadest reasonable interpretation consistent with specification, broadly encompass subject matter where the electronic information is encrypted based upon the medium personal number or where the medium personal number is used to generate a decryption key for decrypting the encrypted electronic data. Matyas discloses these two features. The diskette serial number, as disclosed in Matyas, is used to generate the key and/or the encrypted data is encrypted based on the diskette serial number. That other information, such as program number and computer number, as disclosed in Matyas, are included in the generation of the decryption key or that the encryption is based on such other included information, does not preclude anticipation of the broad recitation of the encryption based on the medium personal number or of generating a decryption key based on the medium personal number, as Matyas discloses that the diskette serial number is used in the formation of the decryption key and/or the encryption of the encrypted information is based on the diskette serial number.

Claim Rejections - 35 USC § 103

4. Claims 3-5, 8-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas (4,757,534) in view of Shear (4,827,508 hereinafter '508).

The '534 patent discloses a diskette as the storage medium while the instant claims provide for optical disks and/or cd-ROMS. The Shear '508 patent teaches a

Art Unit: 2132

security system for metering the usage and billing for the use of a digital database. The digital database is provided on an optical disk or a cd-rom, see col. 2, lines 29-57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an optical disk or cd-rom as taught in Shear '508 for the diskette of Matyas '534 in order to store large amounts of information for distribution to various users. Shear also teaches using different coding for different files stored on the medium, see col. 15, lines 51-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide plural encrypted data each having different coding as taught in Shear '508 in the storage medium of Matyas '534 in order to protect the electronic data according to different uses and/or payment types.

RECAPTURE OF SUBJECT MATTER

5. Claims 17 and 18 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

Art Unit: 2132

U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The instant claims do not include the amendments to the original claims made to overcome a rejection based on non-statutory subject matter. The claims were amended to recite structural and functional relationship to both a user computer and a vendor computer to overcome the non-statutory rejection. See Response filed November 13, 1996 in original application 08/603,760, page 3, first paragraph. Therefore, these claims are seeking to recapture that subject matter which was surrendered to overcome the non-statutory rejection in the original prosecution.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

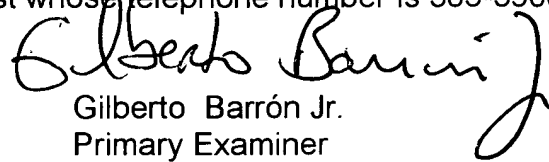
6. Claims 17 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The instant claims are directed to a data structure per se. The recited storage medium comprising a medium personal number and electronic information merely recite data without the required functionality that is conveyed to a general purpose computer to perform a statutory process. The subject matter is not functional descriptive, but rather a list of the information held by the storage medium which constitutes a data structure per se.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is 703-305-1830. The examiner can normally be reached on 7:30-5:00 Mon-Thur, alt Fri.

Art Unit: 2132

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod R. Swann can be reached on 703-308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.



Gilberto Barrón Jr.
Primary Examiner
Art Unit 2132

gbj
December 21, 2000